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DEC 19 2006

ATTORNEY DOCKET NO. 04159.0001U2
APPLICATION NO. 09/632,959

REMARKS

Claims 1-4, 6-7, and 13-18 are pending in the Application. Claims 1, 3, and 8 were rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter the Applicant regards as his invention. Claims 1-9 were rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent Application Publication No. US 2001/0020242 to Gupta ("Gupta") in view of U.S.P.N. 6,505,254 to Johnson ("Johnson"). Claims 5 and 8-12 are canceled and claims 13-18 are added. In view of the Remarks, the Applicant respectfully requests withdrawal of the rejections and allowance of the pending claims.

Rejections under 35 U.S.C. 112, Second Paragraph

Claims 1, 3, and 8 were rejected under 35 U.S.C. 112, second paragraph. To support this rejection, the Office Action on page 2 states:

Claims 1, 3, and 8 provides for the use of obtaining a geographic location of Internet user, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass, such as, in claim 1, step of using the geographic location of the Internet user in handling the request for information from the Internet user (claim 1, lines 13-14) could be done by either external server or internal server;

The Applicant respectfully disagrees with the statement that "Claims 1, 3, and 8 provides for the use of obtaining a geographic location of Internet user, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass" as asserted in the Office Action. To the contrary, the Applicant respectfully asserts that claim 1, for example, recites several steps that clearly define the invention of claim 1. To make this clear, the Applicant will provide a brief description of a problem in the art and how claim 1 provides a novel and unobvious solution to that problem.

As understood by one of skill in the art, a user that accesses an external network from a private network through a proxy server has an internal network address that is not known to computers on the external network. When such a private network user accesses the external

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network, he accesses it using an external network address of the proxy server. Accordingly, it appears to computers on the external network that the external network address represents the private network user, when in fact it represents the proxy server. This presents a problem when a computer on the external network assumes that the external network address represents the private network user and then uses the external network address to determine the location of the user since the private network user may be miles, states, or countries away from the physical location of the proxy server.

To this end, claim 1 provides a novel, unobvious, and distinctly claimed solution to the problem of obtaining a geographic location of an Internet user that accesses an external network from a private network through a proxy server, and recites the steps of:

receiving by an external server on the external network a request for information from an Internet user through the proxy server;

determining by the external server that the request for information is through the proxy server;

redirecting by the external server the request for information to an internal server of the private network, the internal server determining the geographic location of the Internet user;

receiving by the external server the geographic location from the internal server within the private network; and

using the geographic location of the Internet user in handling the request for information from the Internet user.

As can be seen above, claim 1 provides a distinctly claimed solution to the problem of determining the geographic location of a private network user that accesses an external network from a private network through a proxy server by, for example, determining by the external server that the request for information is through the proxy server and then redirecting by the external server the request for information to an internal server of the private network, the internal server determining the geographic location of the Internet user. Accordingly, the Applicant respectfully asserts that claim 1 particularly points out and distinctly claims the subject matter that the Applicant regards as his invention, and respectfully requests that the rejection be

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withdrawn. For at least the same reasons, claim 3 also particularly points out and distinctly claims the subject matter that the Applicant regards as his invention. Thus, the Applicant respectfully requests that the 112 rejections of claim 3 be withdrawn.

The Applicant also respectfully asserts that the bases for the 35 U.S.C. 112, second paragraph rejections are improper. To support rejections of claims 1, 3, and 8, the Office Action states:

in claim 3, also the examiner is not quite clear who processes the steps of receiving a request for the geographic location of the Internet user within the private network, . . . (claim 3, lines 4-5), this step could be done by either other external network, other Internet user or internal server; . . . (Emphasis added)

Claims 1, 3, and 8 (now cancelled) are method claims, and as such define a series of steps for performing a process. Since a method claim defines a process, there is no requirement to specify in the claim the "who" or "what" performs the claimed method. Thus, the Applicant asserts that the 112 rejections of claims 1 and 3 are improper and respectfully requests that they be withdrawn. The 112 rejection of claim 8 is no longer applicable because claim 8 has been canceled.

Rejections Under 35 U.S.C. §103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, (Fed. Cir. 1991).

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Independent Claim 1

Claim 1 stands rejected as obvious over Gupta and Johnson. To support a rejection of claim 1 as obvious, the Office Action states that Gupta discloses:

determining by the external server that the request for information is through the proxy server: (Gupta discloses communications between users/ clients with "Web servers" which is equivalent to "external server" through "ISPs/or Proxies" which is equivalent to "the proxy servers"; while traveling, the user may roam into another ISP to access a web server; Gupta discloses when the user roams into another ISP, the ISP may forward the request to the user's home ISP based upon user profile such as residence and /or phone number : [0060]; figure 1, item 100, 102 and 104; figure 6, items 400, 402, 406)

Paragraph [0060] of Gupta discloses:

In addition to the above, a user or client 100 may roam into another ISP. This may occur when a user is traveling and dials into a phone number for a third party ISP or when the web browser utilizes the proxy of a third party ISP, for example. When client 100 roams into another ISP, the ISP may forward the request to the user's home ISP for local advertisement insertion (as described below), the ISP may obtain the profile information from the user's home ISP and use it for advertisement insertion, or the user's roaming profile can be returned to the home ISP. The above options and other options are demonstrated in FIG. 4, for example. If client 400 is roaming and utilizes ISP2 404, ISP2 404 may retrieve or purchase the user's profile from the user's standard ISP, ISP1 402. Under such an option, client 400 utilizes pathways B, C, and E to access web server 406. Alternatively, ISP2 may act as a path through for ISP1 with ISP1 providing the access to web server 406. Under this option, client 400 utilizes pathways B, C, and D to access web server 406 and ISP1 402 will perform any advertisement insertion. In another embodiment, ISP2 utilizes the current access profile of client 400 to place any advertisements. Under this embodiment, client 400 utilizes pathways B and E to access web server 406. In another embodiment, ISP2 404 negotiates with web server 406 for an advertisement insert and after concluding negotiations, offers ISP1 402 the option of inserting the advertisement for the same or an increased price. Under this option, client 400 utilizes pathways B, E, and C to access web server 406. In each of the above roaming user

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embodiments, ISP2 404 can return or sell the dynamically generated user profile (for that online session) to the user's standard ISP, ISP1 402. (Emphasis added)

The above cited language from Gupta discloses “a user is traveling and dials into a phone number for a third party ISP or when the web browser utilizes the proxy of a third party ISP, for example” and “When client 100 roams into another ISP, the ISP may forward the request to the user's home ISP for local advertisement insertion (as described below), the ISP may obtain the profile information from the user's home ISP and use it for advertisement insertion, or the user's roaming profile can be returned to the home ISP.” While the cited language from Gupta does reference “ISPs” and “proxies”, none of the cited language discloses determining by an external server that a request for information is through a proxy server as recited in claim 1.

When the above citations are understood in the full context of Gupta, it is apparent that Gupta does not disclose determining that a request is through a proxy server because such a determination is useless to the invention of Gupta. Specifically, Gupta discloses storing user profile information in a proxy server that is on the Internet. Gupta at [0017]; [0053]; [0054]; [0055]; and [0057]. Since the profile information of Gupta is stored on a computer on the Internet, an external network, the invention of Gupta has no need to “look behind” the proxy to access information. Accordingly, Gupta does not disclose, and has no reason to disclose, determining that a request for information is through a proxy as recited in claim 1. Thus, the Applicant respectfully asserts that claim 1 is allowable for at least the reason that Gupta does not disclose the determining step of claim 1.

To support a rejection of claim 1 as obvious, the Office Action states that Gupta discloses:

Receiving by the external server the geographic location for [from] the internal server within the private network: (Gupta discloses the Internet Service Providers (ISPs)/or proxies owned by ISP collect and store information regarding particular users in a user profile such as the user's age, “residence, phone number, email address” which is equivalent to “geographic location.” Etc. The user profile also may be sent to another ISPs” [0033]; [0058]; [0080])

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As discussed above, Gupta uses words such as "home ISP", "third party ISP", and "proxy" to refer to various systems or segments on networks. Each of the disclosed systems or segments of Gupta, including the proxy of Gupta, resides on the Internet, an external network. While Gupta does disclose storing a user profile and sending that profile to another ISP, the profile of Gupta is stored at a proxy on an external network. In contrast, claim 1 recites receiving the geographic location from a server within the private network. Thus, the Applicant respectfully asserts that claim 1 is allowable for at least the reason that Gupta does not disclose receiving the geographic location from the internal server within the private network as recited in claim 1.

To support a rejection of claim 1 as obvious, the Office Action relies on a combination of Gupta and Johnson, stating:

However, Gupta does not explicitly disclose using the geographic location of the Internet user in handling the request information for the Internet user; redirecting by the external server the request for information to an internal server of the private network, the internal server determining the geographic location of the Internet user.

In analogous art, Johnson discloses a system and method of routing and redirecting a service request to "appropriated router" which is equivalent to "server" based upon the address of the service request within the preferred coverage zone; each individual router has its regular coverage zone; wherein the coverage zones is a set of the addresses that the router will be willing to serve if the service request came from one of the addresses: (abstract, lines 1-21; column 4, lines 1-67)

Johnson discloses methods for routing requests in a network by arranging routers dynamically into a hierarchy. Johnson at Abstract; Col. 1, lines 41-59. Johnson arranges routers into "coverage zones" to create a hierarchy of routers. Johnson at Col. 1, lines 41-59; Col. 2, lines 5-23. Johnson for example discloses that a server in a hierarchy receives a query from a server to be registered and sends identification to its children to the server to be registered. Johnson at Col. 2, lines 39-42. Johnson then discloses that the server that received the query and its children is selected on the basis of its expected online performance with the server to be

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registered, and that if the selected server is the server that received the query, the server to be registered is attached to the server that received the query. Johnson at Col. 2, lines 42-47.

The Applicant respectfully asserts that the methods for arranging routers into hierarchies as disclosed in Johnson, discussed above, do not disclose redirecting by the external server the request for information to an internal server of the private network, the internal server determining the geographic location of the Internet user as recited in claim 1. Johnson makes no reference to the geographic location of a user as recited in the redirecting step of claim 1. Similarly, Johnson makes no reference to using the geographic location of the Internet user in handling the request for information as recited in the using step of claim 1. Accordingly, the Applicant respectfully asserts that claim 1 is allowable for at least the reason that Johnson's disclosure, which relates to arranging routers into a hierarchy utilizing coverage zones, does not disclose redirecting by the external server the request for information to an internal server of the private network, the internal server determining the geographic location of the Internet user as recited in claim 1, and for at least the reason that Johnson does not disclose using the geographic location of the Internet user in handling the request for information from the Internet user as recited in claim 1.

Therefore, the Applicant respectfully submits that Gupta and Johnson, taken singly or together, do not disclose every step of claim 1. For at least this reason, the Applicant also respectfully submits that there is no motivation to combine the cited references, absent hindsight reconstruction.

Independent Claim 3

Claim 3 has been amended to incorporate claim 5, and the Applicant asserts that no new matter has been added. To support a rejection of claim 3, the Office Action states that claim 3 is rejected under the rationale of claim 1. The Applicant respectfully traverses the rejection of claim 3 and asserts that claim 3 is allowable for at least the reasons given for the allowability of claim 1.

To support a rejection of claim 5 (which has been canceled and incorporated into claim 3) the Office Action states:

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In addition to the rejection of claim 3, Gupta-Johnson further discloses determining the geographic location comprises determining the geographic location based on an internal address associated with the Internet user and a geographic location/internal IP address mapping table contained within the private network: (Johnson discloses each individual router has its regular coverage zone; wherein the coverage zones is a set of the addresses that the router will be willing to serve if the service request came from one of the address: (abstract, lines 1-21; column 4, lines 1-67)

As discussed above, Johnson discloses arranging routers into a hierarchy utilizing coverage zones, but does not disclose determining the geographic location of a user as recited in claim 3, as amended. Specifically, the Applicant respectfully asserts that the cited language from Johnson does not teach or disclose determining the geographic location based on a geographic location/internal IP address mapping table contained within the private network as recited in claim 3. Johnson makes no reference to the geographic location of a user and so logically does not disclose a geographic location/internal IP address mapping table contained within the private network as recited in claim 3. Thus, the Applicant asserts that claim 3 as amended is allowable for at least the reason that Johnson does not disclose the use of a geographical location/internal IP address mapping table to determine the location of a user as recited in claim 3. For at least the same reason, there can be no motivation to combine the references absent hindsight reconstruction.

Dependent Claims 2 and 6

Claim 6 has been amended to depend from claim 1, and the Applicant asserts that no new matter has been added. As discussed with regard to claim 3, the Applicant respectfully asserts that claim 6 is allowable for at least the reason that Johnson does not disclose the use of a geographical location/internal IP address mapping table to determine the location of a user as recited in claim 6. Claims 6 and 2 are also allowable for at least the reason that each depends from allowable claim 1.

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Dependent Claim 7

The Applicant respectfully asserts that claim 7 is allowable for at least the reason that it depends from allowable claim 3.

Independent Claim 13

Claim 13 has been newly added by amendment and represents elements from allowable claims 1 and 3. Thus, the Applicant asserts that no new matter has been added and that claim 13 is allowable for at least one or more of the reasons given for the allowability of claims 1 and 3.

Dependent Claims 14-18

Claims 14-18 have been newly added by amendment, and the Applicant respectfully asserts that no new matter has been added. Claim 14 defines the internal and external networks as IP networks. The using step of claim 15 is akin to the using step of claim 1. Claims 16-18 recite wherein the user is one of a plurality of users on the private or internal network that accesses the external network using a first external network address of the proxy server, and has support in the Application at least at Figure 15; page 38, lines 6-22; and page 40, lines 3-16.

The Applicant respectfully asserts that claims 14-18 are allowable for at least the reason that each depends from an allowable claim.

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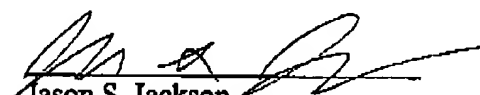
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CONCLUSION

In view of the above, each of the presently pending claims in the Application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass the Application to issue. No additional fee is believed due. However, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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